

REMARKS

I. Introduction

Claims 1 to 3, 9, and 11 to 23 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Objection to the Specification

While Applicant may not agree with the present objection, to facilitate matters, the specification has been amended herein without prejudice to include description of the indentations shown in originally filed Figures 1 to 4. In this regard, it is respectfully submitted that originally filed Figures 1 to 4 clearly show that indentations may be tapered. No new matter has been added.

Withdrawal of this objection is therefore respectfully requested.

III. Rejection of Claims 1, 2, 9 and 11 to 23 Under 35 U.S.C. § 103(a)

Claims 1, 2, 9 and 11 to 23 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 4,372,092 ("Lopez") and U.S. Patent No. 7,121,061 ("Jazzar"). It is respectfully submitted that the combination of Lopez and Jazzar does not render unpatentable the presently pending claims for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). In addition, as clearly indicated by the Supreme Court, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. See KSR Int'l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). Further, the Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. M.P.E.P. §2143.

Claim 1 relates to a modular building system, comprising (a) *multiple portable pre-cast modules*, wherein each of the multiple modules include (i) structural steel mesh; (ii) cementitious mortar encasing the structural steel mesh;

and (iii) *tapered indentations located along edges of the module and exposing portions of the structural steel mesh*; (b) metal plate connectors; and (c) *welds between the metal plate connectors and the exposed portions of the structural steel mesh thereby connecting adjacent modules*, in which *the tapered indentations located along edges of the adjacent modules are aligned with each other, the metal plate connectors and the welds are situated in the aligned tapered indentations of the adjacent modules, and the adjacent modules form a wall.*

The combination of Lopez and Jazzar does not disclose all of the features included in claim 1. In this regard, Lopez does not disclose the feature of *tapered indentations located along edges of the module and exposing portions of the structural steel mesh*. Indeed, the Final Office Action at page 3 admits that “Lopez does not disclose tapered indentations.” Further, Lopez merely refers to connecting welding plates 18 to each other at corners 11 of a panel 10. (Lopez, col. 4, lines 58 to 63; and Figure 6). Thus, since Lopez does not disclose tapered indentations, Lopez also does not disclose the features of *welds between the metal plate connectors and the exposed portions of the structural steel mesh thereby connecting adjacent modules*, in which *the tapered indentations located along edges of the adjacent modules are aligned with each other, the metal plate connectors and the welds are situated in the aligned tapered indentations of the adjacent modules, and the adjacent modules form a wall.*

The Final Office Action refers to Jazzar as assertedly disclosing the above-recited features of claim 1. In this regard, the Final Office Action at page 3 apparently asserts that element “44 of figure 6 or near 32 of figure 2” constitute tapered indentations, as provided for in the context of claim 1. In this regard, paragraph [0028] of the specification of the present application describes indentations as “a notch or recess in the cementitious mortar that exposes a bar of the structural steel mesh.” In contrast, Jazzar merely describes its notches 44 as “arranged so that the ends of the reinforcing members in the slab 42 are between ones of the notches.” Col. 6, lines 36 to 38; and Figure 6. Thus, Jazzar explicitly states that elements 44 do not expose portions of the structural steel mesh, which is the exact opposite of indentations that do expose a bar of structural steel mesh. Accordingly, elements 44 of Jazzar plainly do not constitute indentations, as described by the specification of the present application. Further, as best as the Final Office Action’s assertion of “*near 32 of figure 2*” can be understood, Jazzar

merely describes a wall member 16 having a reduced thickness flange portion end 32 through which reinforcing bar 28 may extend outwardly. Col. 5, lines 45 to 49; and Figure 2. However, nowhere does Jazzar disclose an indentation such as a notch or recess that exposes portions of structural steel mesh. Accordingly, elements “near 32” of Jazzar plainly do not constitute indentations, as described by the specification of the present application. Therefore, nowhere does Jazzar disclose the feature of tapered indentations located along edges of the module and exposing portions of the structural steel mesh. Moreover, since Jazzar merely refers to notches 44 that do not expose reinforcing members, and reinforcing bar 28 extending from ends 32 of wall members 16 that do not include any notches, Jazzar does not disclose the feature that the tapered indentations located along edges of the adjacent modules are aligned with each other. Further, Jazzar merely describes filling with concrete to connect slab 42 to wall members, thereby forming a monolithic structure. Col. 6, lines 38 to 42. Thus, nowhere does Jazzar disclose the features of welds between the metal plate connectors and the exposed portions of the structural steel mesh thereby connecting adjacent modules, and the metal plate connectors and the welds are situated in the aligned tapered indentations of the adjacent modules.

Accordingly, the combination of Lopez and Jazzar does not disclose, or even suggest, the features of *tapered indentations located along edges of the module and exposing portions of the structural steel mesh, and welds between the metal plate connectors and the exposed portions of the structural steel mesh thereby connecting adjacent modules, in which the tapered indentations located along edges of the adjacent modules are aligned with each other, the metal plate connectors and the welds are situated in the aligned tapered indentations of the adjacent modules, and the adjacent modules form a wall*, as provided for in the context of claim 1.

Accordingly, it is respectfully submitted that the combination of Lopez and Jazzar does not disclose, or even suggest, all of the features included in claim 1. Therefore, it is respectfully submitted that the combination of Lopez and Jazzar does not render unpatentable claim 1 for at least the foregoing reasons.

Thus, as for claims 2, 9 and 11 to 23 which ultimately depend from claim 1 and therefore include all of the features included in claim 1, it is respectfully submitted that the combination of Lopez and Jazzar does not render unpatentable these dependent claims for at least the reasons more fully set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claim 3 Under 35 U.S.C. § 103(a)

Claim 3 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Lopez, Jazzar, and U.S. Patent No. 4,930,677 ("Jolliffree"). It is respectfully submitted that the combination of Lopez, Jazzar, and Jolliffree does not render unpatentable the presently pending claim for at least the following reasons.

Claim 3 depends from claim 1. As more fully set forth above, the combination of Lopez and Jazzar does not disclose, or even suggest, all of the features included in claim 1. Jolliffree also does not disclose, or even suggest, the features included in claim 1 not disclosed by the combination of Lopez and Jazzar, and thus, fails to cure the critical deficiencies noted above.

Accordingly, it is respectfully submitted that the combination of Lopez, Jazzar, and Jolliffree does not disclose, or even suggest, all of the features included in claim 1, from which claim 3 depends. As such, it is respectfully submitted that the combination of Lopez, Jazzar, and Jolliffree does not render unpatentable claim 3, which depends from claim 1.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

V. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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